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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,965	02/11/2004	Vincent Kwan	29617/CL002A	3568

4743 7590 05/18/2005

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

FAISON, VERONICA F

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/776,965	Applicant(s) KWAN, VINCENT	
	Examiner Veronica F. Faison	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-13 and 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-10-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 1 and 22 have been amended, claims 23-25 have been added and claims 5, 6 and 14 have been canceled. Hence, claims 1-4, 7-13 and 15-25 are pending in the application.

Preamble

The preamble limitation "useful for dry erase" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 USPQ 6411.

Election/Restrictions

Newly submitted claim 26 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 26 is directed to a kit comprising a capillary marker and a dry erase board.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 29 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-10, 13, 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsujio (US Patent 6,458,192).

Tsujio teach an erasable ink composition comprising a colorant, a film-forming resin (binder) and a release agent (abstract and col. 1 lines 53-55). The reference teaches that any colorant, including titanium oxide, iron oxide and graphite, may be used and that the particle size of the colorant is about 0.3 to 20 μm (col. 1 line 59-col. 2 line 15). The shape of the colorant is not critical and may be spherical, flaky or fibrous and present in the composition in the amount of 1 to 40 percent by weight (col. 2 lines 30-37). Any film-forming resin (binder) may be present in the amount of 0.5 to 2 percent by weight (col. 2 lines 43-61). The release agent may be present in the amount of 3 to 30 percent by weight, which may be selected from polyethylene glycol, polyoxyethylene alkyl aryl ether and water-soluble wax (col. 2 line 65-col. 3 line 18). Various known additives may also be present in the ink composition such as dispersing agents including the preferred anionic surfactant in the amount of 0.01 to 1 percent by weight and wetting agents (co-solvent) including ethylene glycol, diethylene glycol and glycerin in the amount of 1 to 30 percent by weight (col. 4 lines 16-col. 5 line 6). The ink composition may be used in marker pens, felt-tip pens, ballpoint pens and like writing tools (col. 5 lines 58-61). The reference remains silent to the drying rate of the ink composition. It is the position of the Examiner that similar compositions with similar amounts would provide clear and convincing evidence that would lead one to conclude that the drying rate of the ink on a non-porous substrate would be the same as claimed by applicant.

Tsujio fails to specifically exemplify the use of a flaked metallic pigment as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the flaked metallic pigment as claimed by applicant as Tsujio also discloses the use of colorant that may be flaky but shows no example incorporating them.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsujio (US Patent 6,458,192) in view of Santini et al (US Patent 5,981,626).

Tsujio is described above, but fails to teach the specific release agent set forth in claims 11 and 12.

Santini et al teach a composition comprising a releasing agent including siloxane such as polyalkylene oxide modified polydimethylsiloxanes and polyethylene glycols. (col. 5 line 54-col. 6 line 25).

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced polyethylene glycol with polyalkylene oxide modified polydimethylsiloxane because the substitution of art recognized equivalents as shown by Santini et al would have been within the level of ordinary skill in the art.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsujio (US Patent 6,458,192) in view of Bernhardt et al (US Patent 5,286,291).

Tsujio is described above, but fails to teach the specific surfactant set forth in claim 21.

Bernhardt et al teach a composition comprising an anionic surfactant such as phosphate esters (col. 4 lines 26-27).

Therefore it would have been obvious to one of ordinary skill in the art to use the anionic surfactant of Bernhardt in the composition of Tsujio because Tsujio disclose that an anionic surfactant can be used therefore any anionic surfactant (i.e. phosphate ester) may be used.

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsujio (US Patent 6,458,192) in view of Martick (US Patent 5,169,438).

Tsujio is described above, but fails to teach the specific alcohol and metallic pigment.

Martick teaches an ink composition comprising an aqueous medium, pigment dispersion and a cosolvent (abstract and col. 2 lines 30-55). The reference further teaches that fine particles such as metal or metal oxides including alumina (aluminum oxide), titania (titanium oxide), iron and aluminum (col. 9 lines 51-58) may be used in the ink composition. The reference also teaches that the water-soluble organic solvent may be isopropyl alcohol and glycerol that may be present in the composition.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced glycerol with isopropyl alcohol because the substitution of art recognized equivalents as shown by Martick would have been within the level of ordinary skill in the art.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced titania (titanium

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oxide) with alumina (aluminum oxide) and aluminum because the substitution of art recognized equivalents as shown by Martick would have been within the level of ordinary skill in the art.

Response to Arguments

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-


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272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VFF
5-15-05


J.A. LORENZO
SUPERVISORY PATENT EXAMINER